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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,940	09/27/2001	Syunichi Mukai	JP20000206US1	3357

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EXAMINER

VU, THONG H

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/965,940

Applicant(s)

MUKAI, SYUNICHI

Examiner

Thong H. Vu

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2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-6,8-10,12-18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-10,12-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/05</u> . | 6) <input type="checkbox"/> Other: _____  |

1. Claims 1,3-6,8-10,12-19 and new claims 20-22 are pending. Claims 2,7,11,19 are cancelled.

***Response to Arguments***

2. Applicant's arguments filed 2/22/05 have been fully considered but they are moot to new ground of rejection.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. the claimed invention is directed to non-statutory subject matter.

i.e.: selecting musical pieces that have a numerical ranking **NOT** greater than chosen number.

It is a natural law that the selection was only made based on a given number.

On another way, It was unclear, ambiguous, and not provided any concrete, tangible, useful results to claim an obvious selections (a fixed combination of music pieces selection) with an intention of a user (indefinite, abstract, unpredictable).

Claims 20-22 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

i.e.: downloading a set of musical pieces that have a numerical rankings in the latest hit charts between 1 and a given ranking.

It was unclear, vague and ambiguous to download a set of music between a ranking 1 and a given ranking in what meaning (i.e.: from 1 to 10 out of top100 ranking

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or any music piece between 1-100 such as the songs ranking 1,5, 75,89, etc., out of top 100 ranking)

4. Claims 20-22 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

There is no definition of "a given ranking" in specification. One skill in the art could not develop this invention without undue experimentation.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bernard et al [Bernard 6,578,051 B1].

6. As per claim 1, Bernard discloses a music distribution method for downloading, in response to a request from a user, music data for one more musical pieces (e.g.: top ten songs, specification, 0021) included in the given latest hit charts from a server storing a lot of music data [Bernard, Internet downloaded, col 23 lines 39-45; a listing of the top hits, col 29 lines 3-25] comprising the steps of:

Receiving said request at said server, wherein said request contains a chosen number associated with a given latest hits chart [Bernard, catalog number, col 12 lines 1-18]

On said given latest hits chart, selecting musical pieces that have a numerical ranking NOT greater than chosen number [Bernard, top five hit list, col 35 line 56-col 37 line 26];

For each musical piece selected, determining music data to be downloaded, said music data associated with respective selected musical piece [Bernard, new music selections updates, col 20 lines 38-43];

determining if the information in database needs to be updated [Bernard, update database, col 24 lines 29-41]; and downloaded any new songs [Bernard, new music selections updates, col 20 lines 38-43]

determining whether music data to be downloaded from said server are already stored in a terminal said user and downloading, from said server to said terminal, only music data that are not stored in said terminal (i.e.: update a new song) [Bernard, mapping information, col 29 lines 25-48; new music selections updates, col 20 lines 38-43].

7. As per claim 3, Bernard discloses downloading latest charts list including places, titles and singer names said terminal from said server [Bernard, top-hit list and the feature artists, col 29 lines 3-48]; and updating a hit charts list of the user stored in said

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terminal based on said latest hit charts list [Bernard, new music selections updates, col 20 lines 38-43].

8. As per claim 4, Bernard discloses deleting music data that stored in said terminal and are not included in said latest charts [Bernard, new music selections updates, col 20 lines 38-43].

9. As per claim 5, Bernard discloses said step of determining whether music data to be downloaded from said server are already stored in a terminal of said user includes the step of comparing the titles musical pieces on said latest hit charts list with those said hit charts list held in said user terminal [Bernard, mapping information, col 29 lines 25-48].

10. As per claim 6, Bernard discloses said step determining whether music data to be downloaded from said server are already stored terminal of said user includes the step of transmitting said charts of said user to said server, which then performs said step of comparing the titles of musical pieces on said latest hit charts list with those on said hit charts list held in said user terminal [Bernard, mapping information, col 29 lines 25-48].

11. As per claim 8, Bernard discloses said terminal a portable terminal having a music playback function [Bernard, playback device, col 2 lines 52-60], one or more

downloading terminals are connected to said server via a network and said determining step and said downloading step are performed by connecting said downloading terminal said portable terminal or a storage medium to be loaded said portable terminal [Bernard, portable, col 54 lines 28-50].

12. As per claim 9, Bernard discloses downloading a latest hit charts list including places, titles and singer names to said downloading terminals from said server; and updating hit charts list of the user stored in said portable terminal or said storage medium based on said latest hit charts list [Bernard, top-hit list and the feature artists, col 29 lines 3-48].

13. Claims 12-18 contain the similar limitations set forth of claims 1,3-6,8. Therefore, claims 12-18 are rejected for the similar rationale set forth in claims 1,3-6,8.

14. Claims 20, Bernard discloses a method of distributing music from a server to a user device, comprising the steps of:

Receiving a request from the user device for downloading a set of musical pieces that have a numerical rankings in the latest hit charts between 1 and a given ranking [Bernard, top five hit list, col 35 line 56-col 37 line 26];

Comparing a latest hit chart maintained by the server and a latest hit chart stored on the user device to create a first list of musical pieces [Bernard, a caller selects the top-hits list that are retrieved by BRU, col 29 lines 3-14], wherein the first list contains

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musical pieces that are on the latest hit chart of the server but not on the latest hit chart of the user device that have a numerical ranking in the latest hit chart of the server at a given ranking or less [Bernard, mapping information, col 29 lines 25-48]; and

Downloading, from the server to the user device, only musical pieces that are on the first list [Bernard, new music selections updates, col 20 lines 38-43].

15. Claim 21, Bernard discloses the user device is a portable device having a music playback function [Bernard, playback device, col 2 lines 52-60].

16. Claim 22, Bernard discloses the user device is a PC [Bernard, Fig 4].

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 6:00AM- 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Thong Vu*  
**Primary Examiner**  
**Art Unit 2142**

